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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/498,062    02/04/00    CARACINO

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EXAMINER

MM91/0823

FINNEGAN HENDERSON FARABOW GARRETT  
& DUNNER L.L.P.  
1300 I Street N.W.  
Washington DC 20005

VII, D

ART UNIT

PAPER NUMBER

2841

DATE MAILED:

08/23/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/498,062

Applicant(s)

CARACINO ET AL.

Examiner

Quynh-Nhu H. Vu

Art Unit

2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 27-50 is/are pending in the application.
- 4a) Of the above claim(s) 44-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's election with traverse of Group I (claims 27-43) in Paper No. 9 & 10 is acknowledged. This is not found persuasive because the applicant does not specifically point out supposed errors in the restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 44-47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group II, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9 & 10.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "two metal strips coupled to the metal covering" of claim 29 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 29 is misdescriptive with respect to the drawing. Claim 29 recites that the two metal strips coupled to the metal covering. However, according to the Fig. 2, there is only one metal strip 25 coupled to the metal covering 26.

For examining purpose, examiner interprets claim 29 having one metal strip coupled to the metal covering.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 27, 29, 37-39, 41 and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Engelhardt et al. [US 6,262,375].

Engelhardt et al. disclose in Fig. 1-4 a high temperature superconducting cable comprising: a tubular support (105 or 110); and a plurality of superconducting tapes (120, 125) including a superconducting material enclosed in a metal covering (160) and spirally wound onto the tubular support to form at least an electro-insulated (col. 7, lines 66-67), thermally-insulated (140), and refrigerated superconducting layer (col. 4, lines 37-44); wherein the superconducting tapes comprise a metal strip (190, 195) coupled to the metal covering (160).

As to claim 29, wherein the superconducting tapes comprises two metal strips (190, 195) coupled to the metal covering.

As to claims 37-39, wherein the tubular support is made of metal such as non-magnetic stainless steel (aluminum), or made of copper (col. 4, lines 33-36).

As to claim 41, wherein the tubular support (105) has a spirally wound metal strip structure (col. 6, lines 58-59).

As to claim 42, wherein the tubular support has a tile structure.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 28, 30-36, 40 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelhardt et al.

As to claim 28, the product-by-process limitation "bearable tensile deformation greater than 3% during manufacturing and installation" has not been give weight in determining the patentability of the device claim. See MPEP §2113.

As to claims 30-33, the product-by-process limitation "by welding", "by brazing" or "by gluing" has not been give weight in determining the patentability of the device claim. See MPEP §2113.

As to claims 34-36, Engelhardt et al. do not disclose the metal strip is made of non-magnetic stainless steel, bronze, aluminum. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made of made of non-magnetic stainless steel, bronze, aluminum, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

As to claim 40, Engelhardt et al. do not disclose the tubular support has a continuous structure, either smooth or corrugated. It would have been obvious matter of design choice to employ the continuos structure, either smooth or corrugated, since applicant has not disclosed the continuous structure solves any stated problem or is for any particular purpose.

As to claim 43, Engelhardt et al. do not disclose a winding angle of the superconducting tapes onto the tubular support is smaller than 40 degrees. It would have been obvious matter of design choice to employ the angle smaller than 40 degrees, since applicant has not disclosed the continuous structure solves any stated problem or is for any particular purpose.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Metra et al. [US 6,255,595], Minnich [US 3,643,002], Occhini et al. [US 4,417,093], Aupoix et al. [US 3,730,966] disclose a high temperature superconducting cable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh-Nhu H. Vu whose telephone number is 703-305-0850. The examiner can normally be reached on 7:30-5:00 (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 703-308-3301. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7724 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

QNV  
August 21, 2001

